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REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-8, 10-25, 27-39, and 43-47 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,347,398 to Parthasarathy et al. ("Parthasarathy"). Further, the Office action rejected claims 9, 26, and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Parthasarathy of U.S. Patent No. 6,230,171 to Pacifici et al. ("Pacifici"). Further yet, the Office action rejected claims 1-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

By present amendment, claims 1, 17, 30, and 41-42 have been amended for clarification and not in view of the prior art. Claims 9, 26, and 40 are cancelled. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on December 1, 2005. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

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The present invention is directed, generally, towards behaviors of elements
in a document, in which an encapsulated component (*e.g.*, object), external to the
document, may be invoked to change the behavior (*e.g.*, effects such as style,
behavior, and/or display) of the associated element in the document. That is, the
current content (elements) of the document may be modified by effects (behaviors).
The associations between elements and external behavior components may be
maintained in cascading style sheets, inline with the elements, and/or in various
formats. When the document is provided to a renderer and the renderer parses the
element in the document, the renderer may access the associated external
component to modify a behavior of the page image, by running code such as
script-based code.

Further, each behavior component may be external to the document and its
content. As a result, for example, a library of consistent, reusable behaviors may
be defined and made available for use in designing and authoring many different
web pages with different content. Similar to a library of functions, the same
behavior component may be invoked multiple times in multiple instances as
needed from two or more different documents and may be interfaced with elements
from different documents consistently, without requiring customization and so forth.
Thus, not only may a single behavior be shared among elements of a document,
but a behavior component may also be reused multiple times across other
documents.

Note that the above description is for example and informational purposes
only, and should not be used to interpret the claims, which are discussed below.

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Rejections under §101

The Office action rejected claims 1-29 as being directed to non-statutory subject matter. Applicants respectfully disagree and submit that the claims are directed toward a method and system capable of being carried out in a computer, e.g., a computer-implemented method or computer system. MPEP § 2106(IV)(B)(1) specifically states that "a claimed computer readable medium encoded with a data structure *defines* (emphasis added) structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory." In contrast, MPEP § 2106(IV)(B)(1a) goes on to state further "[d]ata structures *not claimed as embodied in computer-readable media* (emphasis added) are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Claims 1 and 17 recite a computer-readable medium and a computer-implemented method, respectively, each having computer-executable instructions. The computer-executable instructions comprise physical steps that may be carried out in a computing environment. Even if these recitations are considered software, the execution of the method still imparts functionality to the computer-implemented method. When functional descriptive material is recorded on some computer-readable medium, e.g. a computer-implemented method, it becomes structurally and functionally interrelated to the medium and will be statutory since use of technology permits the function of the descriptive material to be realized. See, for example, *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.

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1994) (claim to data structure stored on a computer readable medium that
increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61,
31 USPQ2d at 1759 (claim to computer having a specific data structure stored in
memory held statutory product-by-process claim).

Notwithstanding, claims 1 and 17 have been amended to recite a tangible
computer-readable medium and a computer-implemented method, respectively.
This remains consistent with the specification as a tangible computer-readable
medium and computer-implemented method may still comprise a modulated data
signal such as a carrier wave or other transport mechanism and includes any
information delivery media such as a computer memory which receives such a
carrier wave or modulated signal. Applicants submit that claims 1-29 are statutory
and respectfully request that the rejection under §101 be withdrawn.

Rejections under §102

Turning to the anticipation rejections, amended claim 1 recites a tangible
computer-readable medium having computer-executable instructions, comprising,
receiving a document having an element thereon, the document including
information associating the element with an external component that is
encapsulated and external to the document such that multiple instances of the
external component may be used with a plurality of different documents including
the document having the element thereon and wherein the information associating
the element with the external component is maintained in a cascading style sheet,
rendering a page image corresponding to at least part of the document, the page

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image including a representation of the element, and accessing the external

component for determining a behavior of the representation of the element

rendered on the page image.

The Office action rejected claim 1 as being anticipated by Parthasarathy.

The Office action contends that Parthasarathy teaches the recitations of claim 1

and subsequently refers to the rejection of claim 17 for the specific references to

Parthasarathy. More specifically, the Office action contends that Parthasarathy

teaches encapsulating code in an external component for affecting the behavior of

elements including elements of different documents. Column 6, lines 24-43 of

Parthasarathy is referenced. Further, the Office action contends that

Parthasarathy teaches inserting an element into a document and providing the

document to a renderer. Column 1, line 60 to column 2, line 2 of Parthasarathy is

referenced. Still further, the Office action contends that Parthasarathy teaches

rendering a page image corresponding to at least part of the document, the page

image including a representation of the element, and accessing the external

component for determining a behavior of the representation of the element

rendered on the page image. Column 5, line 35, and column 8, line 24 of

Parthasarathy are referenced. Applicants respectfully disagree.

Notwithstanding applicants' disagreement, claim 1 has been amended to

include the recitation of claim 9 and claim 9 has been cancelled. The Office action

concedes that Parthasarathy does not teach the recitation of former claim 9

wherein the information associating the element with the external component is

maintained in a cascading style sheet. Given this concession, the only possible

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rejection based on Parthasarathy that could be made would be a §103(a)

obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may

be removed from consideration as this reference qualifies as prior art only under

§102(e) and may not be used to preclude patentability on obviousness grounds,

because Parthasarathy, at the time the present claimed invention was made, was

subject to an obligation of assignment to the same entity. A statement to establish

common ownership of both the present invention and the Parthasarathy reference

is attached below.

For at least these reasons, applicants submit that claim 1 is patentable over

Parthasarathy whether considered alone or in any permissible combination with

any prior art of record.

Applicants respectfully submit that dependent claims 2-8 and 10-16, by

similar analysis, are allowable. Each of these claims depends either directly or

indirectly from claim 1 and consequently includes the recitations of independent

claim 1. As discussed above, Parthasarathy does not teach the recitations of claim

1 as amended. In addition to the recitations of claim 1 noted above, each of these

dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 17 recites a

computer-implemented method of providing dynamic effects to an HTML

document, comprising, encapsulating code in an external component that may

affect a behavior of one or more elements, including elements of different

documents, inserting an element into a document, attaching a reference in the

document to associate the element with an instance of the external component,

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such that another instance of the element may be referenced by a different

document wherein the reference associating the element with the external

component is maintained in a cascading style sheet, and providing the document to

a renderer.

The Office action rejected claim 17 as being unpatentable over

Parthasarathy. More specifically, the Office action contends that Parthasarathy

teaches encapsulating code in an external component for affecting the behavior of

elements including elements of different documents. Column 6, lines 24-43 of

Parthasarathy is referenced. Further, the Office action contends that

Parthasarathy teaches inserting an element into a document and providing the

document to a renderer. Column 1, line 60 to column 2, line 2 of Parthasarathy is

referenced. Further yet, the Office action contends that Parthasarathy teaches

attaching a reference In the document to associate the element with an instance of

the external component, such that another instance of the element may be

referenced by a different document. Column 9, beginning at line 63 of

Parthasarathy Is referenced. Finally, the Office action contends that Parthasarathy

teaches providing the document to a renderer. Column 7, lines 27-36 of

Parthasarathy is referenced. Applicants respectfully disagree.

Notwithstanding the applicants' disagreement, claim 17 has been amended

to include the recitation of claim 26 and claim 26 has been cancelled. The Office

action concedes that Parthasarathy does not teach the recitation of former claim 26

wherein the information associating the element with the external component is

maintained in a cascading style sheet. Given this concession, the only possible

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rejection based on Parthasarathy that could be made would be a §103(a)

obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may

be removed from consideration as this reference qualifies as prior art only under

§102(e) and may not be used to preclude patentability on obviousness grounds,

because Parthasarathy, at the time the present claimed invention was made, was

subject to an obligation of assignment to the same entity. A statement to establish

common ownership of both the present invention and the Parthasarathy reference

is attached below.

For at least these reasons, applicants submit that claim 17 is patentable

over Parthasarathy whether considered alone or in any permissible combination at

law.

Applicants respectfully submit that dependent claims 18-25 and 27-29, by

similar analysis, are allowable. Each of these claims depends either directly or

indirectly from claim 17 and consequently includes the recitations of independent

claim 17. As discussed above, Parthasarathy, does not teach the recitations of

claim 17 and therefore these claims are also allowable over the prior art of record.

In addition to the recitations of claim 17 noted above, each of these dependent

claims includes additional patentable elements.

Turning to the last independent claim, amended claim 30 recites in a

computer system, a system for rendering page images on a display, comprising an

external component encapsulating code for modifying a behavior of one or more

elements, the external component operable to be instantiated multiple times and

operable to modify elements in a plurality of different documents and wherein the

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information associating the element with the external component is maintained in a

cascading style sheet, and a renderer connected to the display for rendering page

images, the renderer receiving a document having an element specified therein

and information associating the element with the external component, the renderer

rendering a page image corresponding to the document and accessing the external

component for modifying the page image..

The Office action rejected claim 30 as being unpatentable over

Parthasarathy. The Office action contends that Parthasarathy teaches the

recitations of claim 30 and subsequently refers to the rejection of claims 1 and 17

for the specific cites to Parthasarathy. Applicants respectfully disagree.

Notwithstanding the applicants' disagreement, claim 30 has been amended

to include the recitation of claim 40 and claim 40 has been cancelled. The Office

action concedes that Parthasarathy does not teach the recitations of former claim

40 wherein the information associating the element with the external component is

maintained in a cascading style sheet. Given this concession, the only possible

rejection based on Parthasarathy that could be made would be a §103(a)

obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may

be removed from consideration as this reference qualifies as prior art only under

§102(e) and may not be used to preclude patentability on obviousness grounds,

because Parthasarathy, at the time the present claimed invention was made, was

subject to an obligation of assignment to the same entity. A statement to establish

common ownership of both the present invention and the Parthasarathy reference

is attached below.

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Applicants respectfully submit that dependent claims 31-39 and 43-47, by

similar analysis, are allowable. Each of these claims depends either directly or

indirectly from claim 30 and consequently includes the recitations of independent

claim 30. As discussed above, Parthasarathy, whether considered alone or in any

permissible combination at law, fails to teach or suggest the recitations of claim 30

and therefore these claims are also allowable over the prior art of record. In

addition to the recitations of claim 30 noted above, each of these dependent claims

includes additional patentable elements.

Rejections under §103

The Office action rejected claims 9, 26, and 40-42 as unpatentable over

Parthasarathy in view of Pacifici. Applicants respectfully disagree.

Notwithstanding, claims 9, 26, and 40 have been cancelled to expedite

allowance, and not in view of the prior art. Claims 41 and 42 have been amended

to depend from claim 30 instead of canceled claim 40; (again, the amendments

were not in view of the prior art). Applicants submit that while the combination of

Parthasarathy and Pacifici is improper as a matter of law, the point is moot, as

Parthasarathy cannot be used to support a §103(a) rejection because

Parthasarathy, at the time the present claimed invention was made, was subject to

an obligation of assignment to the same entity. A statement to establish common

ownership of both the present invention and the Parthasarathy reference is

attached below.

For at least these reasons, applicants submit that all the claims are

patentable over the prior art of record. Reconsideration and withdrawal of the

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rejections in the Office action is respectfully requested and early allowance of this
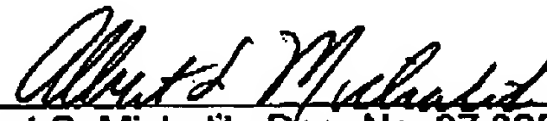
application is earnestly solicited.

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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-8,

10-25, 27-39 and 41-47 are patentable over the prior art of record, and that the

application is in good and proper form for allowance. A favorable action on the part

of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the

prosecution of the subject application, the Examiner is invited to call the

undersigned attorney at (425) 836-3030.

Respectfully submitted,

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STATEMENT TO ESTABLISH COMMON OWNERSHIP

(Regarding U.S. Patent No. 6,347,398)

Applicants, through the attorney of record, state that the present application

and each of the above-identified references were, at the time the invention was

made, owned by, or subject to an obligation of assignment to the same entity.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Response, along with transmittal, Statement to Establish

Common Ownership, and facsimile cover sheet, are being transmitted by facsimile

to the United States Patent and Trademark Office in accordance with 37 C.F.R.

1.6(d) on the date shown below:

Date: December 21, 2005   _____
                                               Albert S. Michalik

1890 Amendment After second RCE

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